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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,173	02/14/2001	David Moy	370077-3000	2184

7590 05/06/2002

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EXAMINER
HENDRICKSON, STUART L

ART UNIT	PAPER NUMBER
1754	4

DATE MAILED: 05/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-4

Office Action Summary

Application No.	Applicant(s)
09/783,123	May
Examiner	**Group Art Unit**
Hutchison	1794

—The MAILING DATE of this communication appears on th cover sheet beneath th correspondence address—

P riod for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☐ Responsive to communication(s) filed on 2/13/02.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-91 is/are pending in the application.

Of the above claim(s) 22, 23, 28, 29, 33, 34, 40-41, 45, 46, 52-91 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-21, 24-27, 30-32, 35-39, 42-44, 47-51 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claim(s) 1-91 are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Notic of Reference(s) Cited, PTO-892

☐ Notice of Draftsperson's Patent Drawing Revi w, PTO-948

☐ Int rvi w Summary, PTO-413

☐ Notice of Informal Pat nt Application, PTO-152

☐ Other _____

Office Action Summary

Applicant's election with traverse of Group I in Paper No. 3 is acknowledged. The traversal is on the ground(s) that the search is the same. This is not found persuasive because the search is different for each group. Further, 'catalyst' claims 62-67 are in fact fibrils themselves and are appropriate where they are presently grouped. The requirement is still deemed proper and is therefore made FINAL.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-21, 24-27, 30-32, 35-39, 42-44 and 47-51 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-55 of U.S. Patent No. 6143689. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are broad enough to include the specific metals patented.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 4, 5, 7-10, 12, 21, 24, 26 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Kamo et al.

Kamo teaches in column 2 and the examples making a catalyst containing Mo and a carboxylate, formed on alumina. Thus, the reference, 'incorporates' a carboxylate into the metal. Even though forming carbon fibers/fibrils is not disclosed, the intended use of the catalyst does not limit it.

Claims 3, 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamo et al. Kamo, supra, does not exemplify treating a preformed catalyst, but suggests it in column 2 bottom. Using this mode is an obvious expedient to make an useful catalyst.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 42-44 and 47-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 42, 44, 47 and 50, 'high degree of structure' is subjective and unclear as to what sort of structure is meant.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (703) 308-2539.

Stuart Hendrickson
examiner Art Unit 1754